

REMARKS**Rejections under 35 U.S.C. §§ 102(b) and 103(a)**

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Hamada et al. (JP 06-282871) (hereinafter "Hamada"). Claims 2, 3/2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamada in view of Minoru (JP 2002-008269) (hereinafter "Minoru"). Claim 3/1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamada. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamada in view of Sako et al. (U.S. Patent No. 7,287,167) (hereinafter "Sako"). The rejections in the Office Action are respectfully traversed for at least the following reasons.

In sections 1-2 of the Office Action, at pages 2-3, the Examiner asserts that the claimed feature of "wherein cover layer, recording layer and substrate are disposed in this order from the side where optical beam is applied" is disclosed at Fig. 2 and paragraph 11 of Hamada. Applicants respectfully traverse such an assertion as being technically inaccurate for at least the following reasons.

Applicants respectfully submit that Hamada does not explicitly disclose the application direction of the optical beam to the optical information recording medium 10 of Hamada. Based on the disclosure in paragraph 11 of Hamada and the position-relation between the reflection layer 18 and the cover layer 20 disclosed in Fig. 2 of Hamada, Applicants believe that Hamada merely discloses an optical information recording medium in which "the substrate 12, recording layer 14 and cover layer 14 are disposed in this order from the side where optical beam is applied." In other words, Applicants respectfully submit that the application direction of the optical beam for recording of Hamada is upward in Fig. 2 of Hamada. Applicants respectfully

submit that the optical beam is thus applied in an opposite direction to the optical information medium in comparison to the optical beam of the instant application's invention. As a result, Applicants respectfully submit that the assertions in the Office Action in this regard are clearly based on an incorrect technical understanding. Withdrawal of the rejection of independent claim 1 under 35 U.S.C. § 102(b) is thus respectfully requested for at least the foregoing reasons.

In sections 3-9 of the Office Action, at pages 3-7, with regard to the rejections of claims 2-4 under 35 U.S.C. § 103(a), the Examiner repeats the previous assertion that the claimed feature of "wherein cover layer, recording layer and substrate are disposed in this order from the side where optical beam is applied" is disclosed at Fig. 2 and paragraph 11 of Hamada. However, as stated previously with regard to the rejection under 35 U.S.C. § 102(b), Applicants respectfully traverse such an assertion as being technically inaccurate for at least the reasons discussed previously in detail. Applicants respectfully submit that the additionally applied references to Minoru and Sako do not cure the deficiencies of Hamada, as discussed above.

With regard to the rejections of the dependent claims 2 and 3, Applicants respectfully submit that these dependent claims are allowable at least because of their dependence from their respective base claim 1, and the reasons previously discussed.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(b) and 103(a) should be withdrawn because the applied art of record does not teach or suggest each feature of claims 1-4 of the instant application. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 2

USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)."

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

DRINKER BIDDLE & REATH LLP



By:

Paul A. Fournier

Reg. No. 41,023

Dated: January 31, 2008

Customer No. 055694

DRINKER BIDDLE & REATH LLP

1500 K Street, N.W., Suite 1100

Washington, DC 20005-1209

Tel.: (202) 842-8800

Fax: (202) 842-8465